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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/737,000	12/16/2003	Astrid Gorge	MO 5980/HCSP70	5754
157	7590	09/14/2006	EXAMINER	
BAYER MATERIAL SCIENCE LLC			HENDRICKSON, STUART L	
100 BAYER ROAD			ART UNIT	PAPER NUMBER
PITTSBURGH, PA 15205			1754	

DATE MAILED: 09/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/737,000	GORGE ET AL.	
	Examiner	Art Unit	
	Stuart Hendrickson	1754	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 10 July 2006.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 16, 19-21 and 30-36 is/are pending in the application.
4a) Of the above claim(s) 32-36 is/are withdrawn from consideration.

5) Claim(s) 31 is/are allowed.

6) Claim(s) 16 and 19-21 is/are rejected.

7) Claim(s) 30 is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) Paper No(s)/Mail Date. ____ .
3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____ . 5) Notice of Informal Patent Application
6) Other: ____ .

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 16, 19-21, 30, 31 drawn to making Co hydroxide, classified in class 423, subclass 594.19.

II. Claims 32-36, drawn to Co hydroxide, classified in class 428, subclass 402.

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product may be different and can be made by using a different cobalt salt, or by flame drying.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 32-36 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claims 16, 19, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over SU '570 taken with Provance et al. 4317749.

The reference teaches treating BCC with hydroxide to make cobalt hydroxide. Also taught is making a paste.

The abstract does not teach the suspension or particle size or shape, however Provance teaches in column 3 a paste of cobalt salts of the claimed particle size. Concerning the use of a 'suspension', this is deemed to differ from a paste in the water content.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a suspension of cobalt in the process of '570 because doing so makes the material more readily pumped and stirred, for better reactivity. See also In re Boesch 205 USPQ 215. No difference is seen in the formula of the carbonate versus what the Su reference uses, since it is a hydroxy-carbonate which is an alternate expression for basic carbonate used by '570.

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Concerning the particle size of the product, it is noted that it is the same size range as the starting material, so it appears met since the starting material of the reference can be of a wide range which includes the claimed range. Concerning the spherical shape, no differences are seen since the starting material is of the same size and composition claimed.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over SU '570 taken with Provance et al. as applied to claims 16, 19, 20 above, and further in view of JP '385.

SU does not calcine, but JP does to make the oxide. Performing the calcinations on the '570 product is an obvious expedient to make the valuable product desired by '385. Note that use of a material from one process as the starting material for a different process is an obvious expedient; *In re Kamlet* 88 USPQ 106.

Applicant's arguments filed 7/10/06 have been fully considered but they are not persuasive.

The Declaration is speculative and un-notarized. The applicant should show that SU does not have spherical morphology. Provenance is cited to show that a paste can have the claimed size particles; what it additionally teaches is of no moment. This reference does not address the question of suspension versus paste. However, a suspension is obvious as a matter of dilution—especially since SU places their paste in water. Nor is it presupposed that dilution from paste to suspension will change the particle habit. Rather, it appears that SU has the same starting material, merely in a more concentrated form. It gets diluted and calcined (JP reference) but retains its form. It is noted that in claim 1, CO should be removed.

Any inquiry concerning this communication should be directed to examiner Hendrickson at telephone number (571) 272-1351.



Stuart Hendrickson
examiner Art Unit 1754